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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,057	10/12/2004	Hubert Baumgart	PAT-00293	2264

26922 7590 01/19/2006

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EXAMINER
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CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/511,057		BAUMGART ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	William K. Cheung		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>101204</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In view of amendment filed November 14, 2005, the objection of Claim 5 is withdrawn. Further, the objection of claim 19 is withdrawn.

2. In view of Terminal Disclaimer filed November 14, 2005, the provisionally rejection of Claim 1-6 and 8-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/473,730, is withdrawn. Further, the rejection Claim 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-4 of copending Application No. 10/473,730, is withdrawn.

3. In view of argument filed November 14, 2005, the rejection of Claims 1, 4-9, 13-14 and 16-19 under 35 U.S.C. 103(a) as being unpatentable over Barancyk et al. (US Patent 6,111,001) in view of Melamed (US Patent 2,847,399), is withdrawn. The rejection of Claims 2 and 10 under 35 U.S.C. 103(a) as being unpatentable over Barancyk et al. (US Patent 6,111,001) in view of Melamed (US Patent 2,847,399) as applied to claim 1 above, and further in view of Piester (US Patent 5,264,486), is withdrawn. The rejection of Claims 3 and 11 under 35 U.S.C. 103(a) as being unpatentable over Barancyk et al. (US Patent 6,111,001) in view of Melamed (US Patent 2,847,399) as applied to claim 1 above, and further in view of Klemarczyk et al.

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(US Patent 5,679,719), is withdrawn. Further, the rejection of Claims 12 and 15 under 35 U.S.C. 103(a) as being unpatentable over Barancyk et al. (US Patent 6,111,001) in view of Melamed (US Patent 2,847,399) as applied to claim 1 above, and further in view of Reh fuss et al. (US Patent 5,356,669), is withdrawn.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for oligomers and polymers containing at least one allophanate group or at least one carbamate group, does not reasonably provide enablement for oligomers or polymers containing at least one allophanate group and at least one carbamate group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for preparing a urea or a urea derivative prepared by reacting amine with at least one polyisocyanate, does not reasonably provide

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enablement for preparing a urea or a urea derivative prepared by reacting water with at least one polyisocyanate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (line 6-8), the recitation “a urea or a urea derivative prepared by reacting with at least one amine and/or water with at least one polyisocyanate” is considered indefinite. However can a urea or a urea derivative be prepared by reacting water with at least one polyisocyanate?

An improper use of MARKUSH GROUPS is recited in claim 17 (line 2), The term “is one of the group consisting of ..... and ...” is improper. It should be corrected to “is selected from a group consisting of ....., and ...” See MPEP 2173.05 (h).

Claim 10 (line 2) the recitation “modified” is considered indefinite because it is not defined in the specification. What do you mean by that?

Claim 12 (line 3), claim 13 (line 3), claim 14 (line 1), the recitations “complementary” are considered indefinite because the recited term is not defined in the specification. What does “complementary” mean in reference to allophanate groups and carbamate groups?

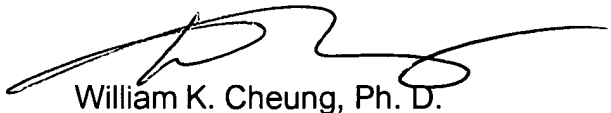
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

January 13, 2006

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**